

AMENDMENT UNDER 37 C.F.R. § 1.111
U.S. APPLICATION NO. 09/805,185
ATTORNEY DOCKET NO. Q63490

REMARKS

Claims 1-11 are all the claims pending in the application.

Applicant would like to thank the Examiner for withdrawing the rejections of claim 1-4 and 7 based on the Barbera, Murazaki, and Takekosh references.

To summarize, in the present non-final Office Action after Request for Continued Examination (RCE), the Examiner rejects claims 1-3, 5, and 7 under 35 U.S.C. § 103(a) as being obvious over Applicant's Admitted Prior Art (APA) in view of DeCruz (U.S. Patent No. 6,422,139), and claim 4 under 35 U.S.C. § 103(a) as being obvious over APA in view of DeCruz, and further in view of JP 11-106685. Claims 6 and 8-11 are allowed. Applicant's remarks on the individual claim rejections are as follows.

I. Preliminary Matters

Applicant amends the claims to make minor changes to conform with U.S. patent practice. For example, claim 5 is amended to correct a minor grammatical error. In particular, Applicant changes "provide" to "provided". Additionally, claims 6 and 8-11 are amended to replace "characterized in that" with "wherein" in conformance with U.S. patent practice. Furthermore, claim 7 also is amended to conform with U.S. patent practice. These amendments are not believed to change the scope of the claims and are intended merely to place the claims in conformance with U.S. patent practice.

II. Drawing Corrections

The Examiner objects to Figures 8-11 because they are not designated by a legend such as "Prior Art". Applicant submits annotated marked-up drawings of Figures 8-11, including the

legend Prior Art. Additionally, Applicant submits ten (10) sheets of Replacement Sheets. The Examiner is requested to kindly acknowledge receipt and approval of the corrected drawings.

III. Allowed Claims

Applicant thanks the Examiner for indicating that claims 6 and 8-11 are allowed.

IV. Illustrative, Non-Limiting Embodiment of Applicant's Invention

Applicant's invention relates to an insertion platform 2' for an image transfer apparatus 1. An image receiving sheet R on which an image is formed and a transfer sheet P onto which an image is to be transferred or superimposed on each other and sent into the image transfer apparatus, which includes a heat roller pair 41 and 42 inside the image apparatus 1 to heat and press the sheets. A part or a whole of the insertion platform 2' for an image transfer structured by a member (see, e.g., 2D, 2F, 2G) provided with a function to transmit the light from the lower side. For example the member may be transparent glass, obscured glass, plastic material, or a light accumulation fluorescent substance. Among other things, since the insertion platform is illuminated from the lower side and the image receiving plate is superimposed on the upper surface of the insertion platform, the image receiving sheet is illuminated by the light from the lower side and match-marks of the image receiving sheet can be visually confirmed from above the transfer sheet. Thus, accurate positioning can be quickly and easily performed. Further, the positioning of the small size image receiving sheet, which is placed under a larger sized transfer sheet, can be simply and correctly conducted.

V. Claims 1-3, 5 and 7:

The Examiner rejects claims 1-3, 5 and 7 under 35 U.S.C. § 103(a) as being obvious over the APA in view of DeCruz. For at least the following reasons, Applicant traverses this rejection.

In the present Office Action, the Examiner alleges that Applicant's admitted prior art discloses all of the elements of the rejected claims except for the use of a light transmission member for a light source and the use of alignment marks. However, the Examiner takes the position that DeCruz makes up the deficiencies of Applicant's admitted prior art. That is, the Examiner alleges that DeCruz teaches a screen printing machine that uses a light box for accurately registering positives with screens. In particular, the Examiner notes that the light box has a light transmission member 2L operable to allow transmission of light from a lower side, a light source of 4 fluorescent lamps 34L mounted to a rigid frame 12L located below the light transmission member 2L, and gridlines 13 serving as alignment marks with their respective reference numbers formed on the light transmission members 2L for aligning the positives (see Figure 7A and column 10, line 49 through column 13, line 48). As such, the Examiner alleges that it would have been obvious to modify the insertion platform of the admitted prior art to include the light transmission member having a light source and alignment marks as disclosed by DeCruz in order to ensure and facilitate accurate registration of the superimposed sheets. Applicant respectfully disagrees with the Examiner's position for several reasons.

It is settled law that the fact that prior art references can be combined is not enough to establish the obviousness of the claimed invention. Instead, the prior art must suggest the

desirability of the combination of the references to arrive at the claimed invention. Moreover, the teachings of the references as a whole must be considered by the Examiner in establishing the obviousness of combining the references. In other words, without a motivation or suggestion in the references or in the art in general to do so, the Examiner cannot selectively choose individual components from the applied references and combine them to arrive at the claimed invention. However, in this case, the Examiner appears to be selecting and combining individual elements of the references without regard for the teachings of the references as a whole.

For example, DeCruz perceived a problem in screen printing that registration of the images is one of the most time consuming steps in a printing job. Therefore, to solve this problem, DeCruz discloses a separate multi-purpose pre-registration unit to simplify and speed up the preparation and registration of the screens. Specifically, DeCruz states:

[T]he invention uses a separate multi-purpose pre-registration unit 2A to simplify and speed up the preparation and registration of the screens. Pre-preparation of the screens and pre-registration of the positives is critical to the print process and represents one of the most time-consuming steps in a print printing job. The use of a separate pre-registration unit eliminates downtime associated with registering the screens at the press and permits the concurrent use of personnel; one person can be setting up jobs at the pre-registration unit while the other person is printing at the press. It also removes the requirement that the press operator be skilled at registration of images. This allows an organization to economically structure its personnel requirements. The pre-registration unit also results in better organization and productivity because it permits a pre-prep person, to set up many jobs ahead of time so they are ready when needed by the press operator.

See col. 10, lines 32-48; emphasis added.

Furthermore, DeCruz states that “[t]his ability to pre-register a screen in a cassette on the pre-registration unit represents a significant improvement over the prior art and eliminates the need to use time at the press for registration” (see col. 11, lines 33-36; emphasis added). In other words, DeCruz addresses the problems associated with registration of the sheets by providing a separate unit from the printing unit that is operated by separate personnel. Therefore, DeCruz solves this problem simply by eliminating the registration process at the printing unit or insertion unit altogether, and accordingly, removing the requirement that the press operator be skilled in the registration of images. Moreover, the separate pre-registration unit of DeCruz includes a complex unit consisting of numerous components, such as tracks for receiving wheels of subassemblies for holding cassettes in place during the pre-registration process, as well as brackets and pins for aligning the cassettes.

In comparison, Applicant’s Admitted Prior Art relates to an “insertion platform for an image transfer apparatus”, not a separate unit for pre-registering the sheets, as taught by DeCruz. In particular, in the Admitted Prior Art, the transfer sheet and image receiving sheet are aligned at the insertion platform by the operator. Additionally, the Admitted Prior Art is concerned with downsizing the overall insertion apparatus (see, e.g., page 5, lines 8-10), while avoiding problems associated with wrinkling or indentation of the sheets as they are fed into the heat rollers.

Therefore, it would not have been obvious to modify the Admitted Prior Art, which discloses an insertion platform for aligning the transfer sheet and image receiving sheet by the operator, based on the DeCruz device, which relates to a pre-registration unit for aligning the

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U.S. APPLICATION NO. 09/805,185
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sheets at a separate location from the printing unit or insertion unit. As such, DeCruz clearly teaches away from such a combination.

Further, since the Admitted Prior Art is concerned with downsizing the overall apparatus, it would not have been obvious to modify the APA based on the DeCruz device, which includes a complex arrangement of multiple components that clearly would teach away from “downsizing” the apparatus.

Accordingly, when considered as a whole for what it teaches to those skilled in the art, DeCruz clearly teaches away from the APA, as well as the claimed invention. Furthermore, the Examiner has not established, nor do the references provide, any motivation for selecting individual elements of the DeCruz reference and combining them with the APA to arrive at the claimed invention.

For at least the foregoing reasons, Applicant respectfully submits that it clearly would not have been obvious to combine the APA and DeCruz to arrive at the claimed invention. Therefore, Applicant requests that the Examiner withdraw the rejection of claims 1-3, 5, and 7 under 35 U.S.C. § 103(a) and allow claims 1-3, 5, and 7.

VI. Claim 4

The Examiner rejects claim 4 under 35 U.S.C. § 103(a) as being obvious over the APA in view of DeCruz, and further in view of JP 11-106685.

In the present Office Action, the Examiner acknowledges that the combination of Applicant’s admitted prior art and DeCruz does not disclose a fluorescent substance coated on the light transmission member, as recited in claim 4. However, the Examiner takes the position

that JP 11-106685 makes up for the deficiencies of Applicant's admitted prior art and DeCruz. For example, the Examiner alleges that JP 11-106685 discloses a luminous coating material containing a fluorescent substance on a display so as to obtain the display having high afterglow luminous. The Examiner considers that it would have been obvious to provide the light transmission member of the Applicant's admitted prior art, as modified by DeCruz, with the fluorescent substance coating of JP 11-106685 in order to achieve a high afterglow luminance of the light transmission member to facilitate the registration process. Applicant respectfully disagrees with the Examiner's position for several reasons.

First, as set forth above, it would not have been obvious to combine at least the APA and DeCruz. Therefore, Applicant submits that claim 4 is patentable at least by virtue of its dependency from claim 1.

Second, Applicant respectfully submits that the Examiner has not provided a reasonable motivation or suggestion to combine the applied references to arrive at the claimed invention. That is, it is not enough merely to identify the individual elements of the claim in a series of individual references, as set forth in the grounds of rejection in the present Office Action. The Examiner cannot dispense with the requirement for providing a suggestion or motivation to combine these individual elements to arrive at the claimed invention.

In this case, neither the APA, DeCruz, nor JP 11-106685 discloses or suggests a light accumulation fluorescent substance that is coated on a light transmission member or its periphery, as recited in claim 4. Instead, DeCruz merely discloses a light source such as a set of four florescent lamps 34L. DeCruz does not disclose the use of a light accumulation fluorescent

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substance. On the other hand, JP 11-106685 merely discloses a luminous coating material in the display. However, JP 11-106685 merely relates to a phosphorescent paint which is aimed at improving brightness by preventing sedimentation of phosphorescent materials and to a display object that uses this paint, such as a dial of a clock. That is, JP 11-106685 does not suggest, or even mention, a light accumulation fluorescent substance that is coated on a light transmission member, or for that matter, that is used in place of a light transmission member for illuminating sheets from below. Therefore, Applicant respectfully submits that a *prima facie* case of obviousness has not been established with respect to at least claim 4. Accordingly, Applicant requests that the Examiner withdraw this rejection and allow claim 4.

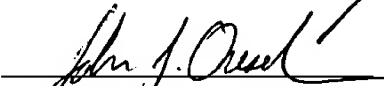
VII. Conclusion

In view of the above, reconsideration and allowance of this application are now believed to be in order, and such actions are hereby solicited. If any points remain in issue which the Examiner feels may be best resolved through a personal or telephone interview, the Examiner is kindly requested to contact the undersigned attorney at the telephone number listed below.

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The USPTO is directed and authorized to charge all required fees, except for the Issue Fee and the Publication Fee, to Deposit Account No. 19-4880. Please also credit any overpayments to said Deposit Account.

Respectfully submitted,



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